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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,651	09/22/2003	Michael Yablonski	H-511C	9504

41245 7590 02/23/2006

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/677,651	Applicant(s) YABLONSKI ET AL.	
	Examiner Dave Willse	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on September 22, 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9-22-03</u> . | 6) <input type="checkbox"/> Other: _____ |

The disclosure is objected to because of the following informalities: The parent application data at the beginning of the specification should be updated. On page 3, line 7, “the Cummings lens” is vague because the art includes numerous intraocular lens plate designs presented by Dr. Cummings; it is recommended that specific reference be made to one or more of the patents subsequently mentioned in the Applicant’s specification. Appropriate correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *elongated* button (e.g., claim 11) must be shown or the feature canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter involving natural parts of a human being (MPEP § 2105, last paragraph). It is recommended that in claim 1, line 9, --configured to be-- or the like be inserted after “and”, first occurrence, in order to avoid positively reciting the engagement with the “natural capsular bag or sulcus” (claim 1, lines 9-10).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, line 4, the word “or” rather than --and-- renders the scope vague and indefinite as to what constitutes the “group of haptics”: the language appears to indicate that said group encompasses looped haptics *or* plate haptics *but not both* because of the term “consisting of” (MPEP § 2111.03). It is recommended that claim 2 be amended so as to employ one of the two formats provided in MPEP § 2173.05(h) just prior to the section entitled “*Subgenus Claim*”. A similar problem occurs in claim 5. In claims 12, 15, and 19, it is recommended that --that of-- be inserted after “than” on line 2 in order to clarify the comparison. In claim 16, line 3, “possibly” renders the claim vague and indefinite in that it is unclear whether the “inferior haptic” is a positively recited element.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lin et al., US 6,533,813 B1, which discloses embodiments that do not employ an artificial bag (e.g., Figures 16 and 17; column 4, lines 50-55), a lens 1 for movement by gravity between posterior and anterior positions within an eye (Figures 8-11; column 4, lines 1-30), and a plurality of haptics (e.g., elements 2, 6, 8 in Figure 17) each articulately connected to the lens 1 at a distal

end and disposed within and connected to the natural capsular bag or sulcus at a proximal end (column 2, lines 17-23).

Claims 5-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al., US 6,533,813 B1. Regarding claim 5, a pin axle or the like would have been an obvious mechanical variant in order to provide greater control over the positioning of the lens 1, especially when the external magnetic source (Figures 22-24; column 5, lines 10-45) is used, in that the bias associated with spring haptic 6 would then be less of an influence on lens position. Regarding claim 6, a posterior equilibrium position appears to be depicted in Figure 24, and such would have been obvious in order to extend the range of accommodation, especially when a patient has access to an external magnetic source with sufficient magnetic attraction and repulsion to effect anterior and posterior equilibrium positions. Regarding claim 8, movement of approximately 1 mm between said equilibrium positions would have been within the realm of obvious variants in order to accommodate a range of patients and corresponding lens prescriptions. Regarding claim 9, incorporating three equally spaced haptics into the embodiment of Figure 17 would have been obvious from the design of Figure 16 in order to better stabilize the implant within the natural capsular bag or the ciliary sulcus. Regarding claim 10 and others, attention is directed to lens button 7 (figures; column 3, lines 53-55). Regarding claim 11 and others, an elongated button would have been an obvious variation on the spaced apart buttons illustrated in Figure 4, 16, 17, and 19 in order to enhance the magnetic forces and to afford greater control over the specific gravity of the lens 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If

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attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

A handwritten signature in black ink, appearing to read 'Dave Willse', is positioned above the printed name.

Dave Willse
Primary Examiner
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